

REMARKS/ARGUMENTS

The rejections presented in the Office Action dated March 23, 2006 (hereinafter "Office Action") have been considered. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

With respect to the §112, second paragraph, rejection of Claims 5, 11, and 16, Applicant has amended each of the claims to remove the objected-to language. Thus, the rejection is moot, and Applicant requests that the rejection be withdrawn.

Claims 1-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,829,484 to Kimoto *et al.* (hereinafter "Kimoto") in view of U.S. Publication No. 2002/0087542 to Itabashi (hereinafter "Itabashi"). Applicant respectfully traverses the rejection because the asserted references, alone or in combination, fail to teach or suggest each of the claimed limitations. For example, the Office Action acknowledges that Kimoto fails to teach encrypting the cell-specific location information on at least one cell of the mobile communication network to be used in the particular mobile communication network by using a predetermined encryption algorithm. In an attempt to overcome this deficiency, the Office Action relies upon the teachings of Itabashi. However, this reliance is misplaced as Itabashi also fails to teach the claimed encrypting of cell-specific location information. The cited portion at paragraph [0070] of Itabashi merely states that a communication terminal may encipher information transmitted to an information center via a base station and network. This information may include identification information of a cellular telephone [0071] or audio information [0064]. Such information is not, nor has the Office Action asserted that such information is, cell-specific location information, as claimed. Thus, neither of the cited references teaches the claimed encrypting of cell-specific location information. As neither Kimoto nor Itabashi teach such limitations, any combination of these teachings must also fail to teach such limitations. Each of the independent claims includes such limitations, thus without a presentation of correspondence to each of the claimed limitations, the §103(a) rejection is improper and should not be maintained. Applicant accordingly requests that the rejection be withdrawn.

The asserted combination of references also fails to teach determining substantially the geographical coverage area of the cell and storing encrypted, cell-specific location information and the geographical coverage area information on the cell in a database such that the two aspects of the information are interlinked. The cited portion of Kimoto at column 7 does not teach any determining of geographical coverage area of a cell and instead merely teaches determining a base station identifier. Kimoto further teaches at lines 25-53 of column 7 that only position information inputted to the mobile terminal and position information of the radio base station (base station identifier) is stored. Thus, Kimoto also fails to teach storing geographical coverage area information and interlinking such geographic information with stored encrypted cell-specific location information. Upon a brief review, Applicant did not find any teachings in Kimoto to correspond to these limitations. Without a presentation of correspondence to each of the claimed limitations, the §103(a) rejection is improper and should be withdrawn.

In addition to having to show that the cited combination of references teaches or suggests all of the claim limitations, the Examiner must show evidence of motivation to combine these references. Applicant respectfully submits that this requirement has not been met.

The Office Action proposes modifying Kimoto's mobile communicating system to include Itabashi's control circuit in order "to provide an information providing system which can prevent verification information or the like being observed or stolen at predetermined settlement locations, prevent unauthorized use, and allow settlement to be performed with a high degree of safety." However, Kimoto is directed to a system providing map information deduced from position information of a mobile terminal by transferring a base station ID. *See, e.g.*, column 35, lines 11-26. Kimoto makes no reference to any sort of settlement or predetermined settlement locations. Applicant fails to recognize any evidence that a skilled artisan would use Itabashi's control circuit to encipher map information as provided by Kimoto's system. Without a presentation of evidence from the cited references that a skilled artisan would be motivated to modify the references as

asserted, the §103(a) rejection is improper. Applicant accordingly requests that it be withdrawn.

Moreover, Applicant respectfully submits that aspects purportedly found in the prior art have been pieced together to arrive at the invention through hindsight. As stated by the Federal Circuit:

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.

In re Dembiczak, 50 USPQ2d 1614, (Fed. Cir. 1999) (citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985)). Without a suggestion of the desirability of "the combination," a combination of such references is made in hindsight, and the "range of sources available, however, does not diminish the requirement for actual evidence." *Id.* It is a requirement that actual evidence of a suggestion, teaching or motivation to combine prior art references be shown and that this evidence be "clear and particular." *Id.* Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

There is nothing in the references or what is in the ordinary skill in the art that would lead to combining the asserted references – rather, the proffered motivation is made in hindsight. For at least the aforementioned reasons, Applicant respectfully submits that a case of *prima facie* obviousness has not been satisfied for lack of a presentation of evidence of motivation to combine the cited references. Applicant accordingly requests that the rejection be withdrawn.

Dependent Claims 2-6 depend from independent Claim 1, dependent Claims 8-13 depend from independent Claim 7, and dependent Claims 15-20 depend from independent Claim 14. Each of these dependent claims also stand rejected under 35 U.S.C. §103(a) as being unpatentable over the above-discussed combination of Kimoto and Itabashi. While Applicant does not acquiesce to any particular rejections to these dependent claims, including any assertions concerning descriptive material, obvious design choice and/or what may be otherwise well-known in the art, these rejections are moot in view of the remarks

made in connection with independent Claims 1, 7 and 14. These dependent claims include all of the limitations of their respective base claims and any intervening claims, and recite additional features which further distinguish these claims from the cited references. "If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious." MPEP §2143.03; *citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent Claims 2-6, 8-13 and 15-20 are also allowable over the combination of Kimoto and Itabashi.

Applicant has also added new Claims 21 and 22 to further characterize the claimed invention. Support for new Claim 21 may be found in the instant Specification, for example, at page 6, lines 1-7 and in original Claim 7; and support for new Claim 22 may be found in the instant Specification, for example, at page 13, lines 15-21 and in original Claim 14. Therefore, new Claims 21 and 22 do not introduce new matter to the application. These new claims are believed to be patentable over the asserted combination of references for the reasons discussed above.

Authorization is given to charge Deposit Account No. 50-3581 (KOLS.049PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact her at the number below to discuss any issues related to this case.

Respectfully submitted,

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